

In re Patent Application Serial No. 10/826,525
Charles D. Kim

Page 2

REMARKS

Applicants appreciate the attention of the Examiner to the application. The Office Action of the Examiner of January 10, 2005 has been reviewed with care in the preparation of this response. The following remarks are believed to be fully responsive to this action.

Status of Claims

Claims 1-19 are pending. The pending claims set forth a novel and non-obvious impact-absorbing level and method of providing impact-absorption to a level. Allowance of all pending claims is respectfully requested in view of the following remarks.

Claims 1-5, 7-15, and 17-19 were rejected under 35 U.S.C. §103(a) as being unpatentable over von Wedemeyer (U.S. Patent No. 5,479,717) in view of Jordan (U.S. Patent No. 3,574,379). Claims 6 and 16 were objected to as being dependent upon a rejected base claim but would be allowable if rewritten in independent form.

The claims are patentably distinguishable over the prior art and the von Wedemeyer and Jordan references in particular. Applicant now turns to the particular points raised by the Examiner in the Office Action of January 10, 2005.

Rejection of Claims 1-5 and 7-8 under 35 U.S.C. §103(a)

Claims 1-5 and 7-8 were rejected under 35 U.S.C. §103(a) as being unpatentable over von Wedemeyer in view of Jordan. Claim 1 is an independent claim with claims 2-8 dependent to it. Applicant respectfully traverses the rejection of these claims and asks that it be withdrawn.

Any prior art reference relied upon by an examiner in a determination of obviousness under 35 U.S.C. §103 must be "analogous prior art." MPEP §2141.01(a). The standard for identifying what constitutes analogous art is well-established: "Two criteria have evolved for determining whether prior art is analogous: (1) whether the art is from the same field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved." *In re Clay*, 966 F.2d 656, 658, 23 USPQ 2d 1058 (Fed Cir. 1992).

In re Patent Application Serial No. 10/826,525
Charles D. Kim

Page 3

Applicant's pending claims are directed to an improved level having end caps. Jordan deals, on the other hand, with a tubular bumper pad mounted onto a vehicle. Jordan is not directed, therefore, to the same field of endeavor as the claimed invention, namely geometric measuring equipment and level indicators in particular.

Moreover, Jordan is not reasonably pertinent to the problem of concern to the Applicant, i.e., the design of a level that can withstand the stress and impact of being bumped or knocked off a surface onto the ground. A person with ordinary skill in the art of hand tools and carpentry equipment would not have been expected to solve such a problem by looking for a reference dealing with a manner of making a better bumper for automobiles. The problem facing the inventor in Jordan was that of the sudden loss of fluid from bumpers with flexible casings upon severe impact. This was not in any manner the problem facing Applicant.

In addition, obviousness under 35 U.S.C. §103(a) can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. In re Jones, 958 F.2d 347 (Fed. Cir. 1992). In addition, any such combination or modification of the prior art must still teach or suggest each and every one of the claim limitations. MPEP §2143.

Von Wedemeyer in combination with Jordan fails, however, to teach or suggest all of the limitations set forth in claim 1. In particular, none of these references, alone or in combination, disclose an end cap having an intermediate layer fixed to an outer layer. Von Wedemeyer, as acknowledged by the Examiner, does not disclose an end cap comprising an outer layer and an intermediate layer fixed to the outer layer. Jordan also fails, however, to disclose such structural elements. FIG. 3 in Jordan does not show body 30, said by the Examiner to be an intermediate layer, secured to or attached to the tubular casing 16, said by the Examiner to include the outer layer, as is needed for the foam to be "fixed" to the casing. Quite to the contrary, body 30 is a spongy foam material that is used to fill the interior of a tubular casing sealed at opposite ends. (Jordan at col. 2, lines 38-40; 52-54).

In re Patent Application Serial No. 10/826,525
Charles D. Kim

Page 4

The additional limitations of claim 4 are also not taught by either von Wedemeyer or Jordan. Claim 4 adds an inner layer connecting the intermediate layer to the body. A connection is "a joining or being joined; coupling; union" according to Webster's New World Dictionary, College Edition © 1966 by The World Publishing Company. No inner layer is disclosed by von Wedemeyer. No connection or union is taught by Jordan between the spongy foam 30 and the rear wall 18 of casing 16 for the same reasons given above with respect to the lack of any attachment between intermediate layer 30 and outer layer 20 of casing 16. FIG. 3 only shows the foam 30 inserted into the casing 16 abutting rear wall 18.

Claim 7 requires the outer layer of the end cap to define an outer profile matching the body profile and the intermediate layer to include a baffled profile. Since end cap 5 in von Wedemeyer is "tapered in external profile outward from the body 2, having a generally frustoconical shape," the outer profile of the end cap 5 in FIG. 14 is not the same profile as that of the "parallepipetal, elongate body 2." (von Wedemeyer at col. 3, lines 38-45). In addition, there is no baffled profile for the spongy foam 30 contents of tubular casing 16 illustrated by FIG. 3 of Jordan since the profile of the foam filling is entirely defined by the shape of the casing 16. In fact, no profile of the foam material 30 is disclosed that even matches the body profile, regardless of whether the bracket structure 14 or the rear bracket 46 is considered the body.

The Examiner states that modification of the level indicator in von Wedemeyer so as to include outer and intermediate layers taught by Jordan would have been obvious to one having ordinary skill in the art at the time the invention was made. Such a statement, however, is not a showing of the motivation needed to arrive at the claimed features that is to be found within the teachings of the references cited. Quite to the contrary, an explanation of how a skilled artisan can extrapolate the claimed invention from either von Wedemeyer or Jordan needs to have been set forth by the Examiner. MPEP §706.02(j).

The lack of any such explanation suggests the lack of a prima facie case of obviousness on which to justify rejections of claims 1-8. It also suggests the type of hindsight that can only be achieved when first there is disclosure by the Applicant of his invention. "To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the

In re Patent Application Serial No. 10/826,525
Charles D. Kim

Page 5

examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." In re Rouffet, 149 F. 3d 1350 at 1357-1358; 47 USPQ 2d 1453 (Fed. Cir. 1998).

One skilled in the art would not have attached a bumper assembly as in Jordan to the level in von Wedemeyer to serve as an end cap even if such a construction was possible. To do so would have destroyed the functionality and utility of the device in von Wedemeyer. Von Wedemeyer teaches two end caps of "relatively hard plastics material" (von Wedemeyer at col. 3, lines 40-41) upon which can be attached "parts with a high coefficient of friction" (von Wedemeyer at col. 4, line 36) to prevent inconvenient slipping of the level (von Wedemeyer at col. 3, lines 50-67). These parts, often strips, are used on certain surfaces of the level, like the surfaces of the end caps themselves, that are expected to make contact with a support or a wall when using the level to apply a marking or to take a measurement. An end cap having a porous body that will yield elastically upon contact would make such features inoperable. It is also highly questionable whether an end cap modeled after the bumper in Jordan would even be able to have the high friction coefficients pieces secured to the outer wall of the casing without damage to the assembly itself. Accordingly, one skilled in the art would have been deterred from mounting von Wedemeyer's level with Jordan's tubular bumper.

For each of the reasons set forth above, claims 1-8 overcome their rejection under 35 U.S.C. §103(a) in the Office Action. Applicants respectfully ask therefore that these rejections be withdrawn.

Rejection of Claims 9-15 under 35 U.S.C. §103(a)

Claims 9-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over von Wedemeyer in view of Jordan. Claim 10-16 are dependent claims of independent claim 9.

As discussed earlier, reliance by the Examiner upon Jordan is misplaced given that the reference constitutes non-analogous prior art. Here again there is also no showing by the Examiner of any motivation for the combination of these references. An explanation as to why a

In re Patent Application Serial No. 10/826,525
Charles D. Kim

Page 6

skilled artisan would have been motivated to select these pieces of prior art so as to arrive at the claimed level is absent from the Office Action but for the conclusory statement by the Examiner mentioned above that the alleged combination would have been obvious. This lack of explanation falls short of the required factual basis on which a rejection under §103(a) must rest. In re Warner, 379 F. 2d 1011; 154 USPQ 173 (C.C.P.A. 1967). One is again left with the impression that the desired modification of the prior art could only be arrived at through the hindsight that comes with the revelation of Applicant's improved level.

Claim 15 adds limitations that the outer profile of the outer layers match the body profile and the intermediate layers include baffled profiles. For the reasons set forth above with regard to the rejection of claim 7, a prima facie case of obviousness has not been made since these elements are not disclosed in either of the references cited.

For all of these reasons, Applicant believes the rejection of claim 9 and claims 10-15 that depend from it have been traversed. Applicant submits that claims 9-16 are now in position for allowance.

Rejection of Claims 17-19 under 35 U.S.C. §103(a)

Claims 17-19 were rejected as well under 35 U.S.C. §103(a) as being unpatentable over von Wedemeyer in view of Jordan. Claim 18 and 19 are dependent claims of independent claim 17.

Claim 17 requires that each end cap have an intermediate layer for connection to the respective end of the body of the level and an outer layer for connection to the respective intermediate layer. No end caps comprising intermediate and outer layers are taught by von Wedemeyer. The alleged intermediate layer 30 disclosed in Jordan, however, has no connection of any sort with an end of the structure to which the bumper is attached. This foam filing 30 is instead no more than a semi-liquid body surrounded by a tubular casing 16. Furthermore, for the reasons set forth earlier with regard to claim 1, the outer layer 20 in Jordan fails to disclose any connection of its own to the spongy foam layer 30 in question.

In addition, reliance by the Examiner upon Jordan is misplaced given that the reference constitutes non-analogous prior art. Moreover, as with the earlier rejections, there is no showing

In re Patent Application Serial No. 10/826,525
Charles D. Kim

Page 7

by the Examiner of any motivation for the combination of these references. The combination of von Wedemeyer with Jordan as proposed by the Examiner would have changed the principles of operation of the devices and thereby rendered construction of any combination inoperable for each of their intended purposes.

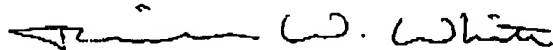
For all of these reasons, Applicant believes the rejection of claim 17 and claims 18 and 19 should be withdrawn and that these claims now be allowed.

Conclusion

Applicant's invention, as set forth in the pending claims, represents a novel level having highly desirable impact-absorbing end caps. Applicant believes these claims have elements not disclosed or suggested in the prior art. Applicant submits that all rejections in the Office Action have been traversed by argument, placing the application in condition for allowance. Early favorable action is earnestly solicited. The Examiner is invited to call the undersigned if such would be helpful in resolving any issues that might remain.

If any extension fee is due, please debit Deposit Account 10-0270 and inform the undersigned.

Respectfully submitted,



Richard W. White
Registration No. 50,601

Dated: April 11, 2005
Jansson, Shupe & Munger, Ltd.
245 Main Street
Racine, WI 53403-1034
Attorney Docket No. EMP-138US
Telephone: 262/632-6900
Telefax: 262/632-2257